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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
PASSANITI, SEBASTIANO	
ART UNIT	**PAPER NUMBER**
3711	

DATE MAILED: 02/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/845,280	THOMAS, FRANK	
	Examiner	Art Unit	
	Sebastiano Passaniti	3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *see detailed Office action*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-27* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *5-25* is/are allowed.

6)☒ Claim(s) *1-4,26 and 27* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

This Office action is responsive to communication received 12/06/2004 – Request for Continued Prosecution (RCE) and remarks.

Claims 1-27 remain pending.

Following is an action on the MERITS:

Claims 5-25 are allowable over the prior art references of record.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-4, 26 and 27 STAND rejected under 35 U.S.C. 103(a) as being unpatentable over Reach in view of JP Patent No. 405329233 (Applicant Seisaku; Inventor Shoichi Tateishi). At the outset, it is noted that, as was the case during earlier prosecution of this application (prior to the filing of an RCE), the JP Patent noted in this rejection will simply be referred to as "Seisaku". Reach shows the invention substantially as claimed and includes an alignment means extending along a portion of the top surface of the head and continuing along onto the hosel segment. The alignment means is in the form of a line that is generally parallel to a plane containing the striking face. Reach, however, does not show a portion of the line extending on the surface of the shaft, whereby a portion of the line extending along a surface of the head and a portion of the line extending along a surface of the shaft are disposed in a common plane with respect to the longitudinal axis of the shaft and parallel to a plane

containing the striking face. The Japanese reference to Seisaku shows it to be old in the art to include an alignment means in the form of a line-shaped piece of tape along the shaft in a direction that is parallel to the face of the putter. In both Reach and Seisaku, the intent is to provide a golfer standing at address with the ability to more readily align the striking face with a ball and the target. In essence, the tape in the Seisaku device is aligned in a perpendicular fashion with respect to an imaginary line that extends to a target point on the green. Thus, the face in the Seisaku device is naturally also aligned in a perpendicular fashion with respect to the same imaginary line. This is clearly evident from Figures 1 and 8 in Seisaku. Taken as a whole, the references to Reach and Seisaku collectively teach that an alignment means such as a line may be placed along a path parallel to the plane of the striking face to help a player orient the club at address. It would appear that alignment is facilitated by either a line on a combination of the head and hosel segments of the head or a line on the shaft itself. Clearly, placing the alignment means on both the head and the shaft merely enhances the alignment effect. Either design for the line would appear to equally provide an appropriate visual alignment tool, which a golfer may use to properly place the putter head with respect to a golf ball at address. In view of the patent to Seisaku and the above reasoning, it would have been obvious to modify the device in the cited reference to Reach by extending the line (c) along the shaft (b), the motivation being to simply enhance the effect of the alignment means. Specific to claim 27, Seisaku clearly obviates the use of a flat striking face in a vertical plane. Again, see Figures 2 and 8 in Seisaku.

Claim 1 is objected to because of the following informalities: The last paragraph of claim 1 would appear to be somewhat inconsistent with the language used in the specification, thereby making the claim, though understandable, somewhat misleading. It is strongly suggested that the applicant clarify claim 1 to set forth that the alignment device extends along a surface of the club shaft and a surface of the head in a common plane with the longitudinal axis of the shaft and parallel to the striking face of the head. This would be consistent with both the language on page 2 of the specification and the language used in subsequent claim 26. In addition, the adoption of this suggestion would be commensurate with the observations made by the Board in its Decision handed down on 08/15/2003 (see Decision on Appeal, page 5). Appropriate correction is required.

RESPONSE TO ARGUMENTS

In the arguments received 12/06/2004, the applicant contends that the Maltby Declaration, submitted 10/07/2004, sets forth a series of facts that must be considered, as highlighted on pages 2 and 3 of the 12/06/2004 remarks (pages 2, 3). Specifically, the applicant, through a reading of the Maltby declaration, alleges **(A)** that the face (a2) of the putter head illustrated in Fig. 2 of the Reach patent has an inclined angle of loft to the vertical plane and thus the sighting line (c) cannot be used to place the face (a2) in a vertical plane. In addition and with further reference to the Maltby declaration, the applicant alleges that **(B)** the Reach prior art does not describe or teach that the sighting line (c) is in a common plane with a longitudinal axis of a putter shaft. The

applicant further asserts that **(C)** the face (a2) of Reach would not be in a plane parallel to any sighting line that is extended up the shaft (b) of Reach. Last, the applicant contends that **(D)** the Seisaku reference does not teach that the straight edge of the tape is to be in a common plane with the axis of the golf shaft.

In response to these arguments, and with respect to **(A)** above, it is noted that the Reach patent repeatedly details that the sight line (c) is intended to aid in squaring of the club face to the line of play. See page 1, column 1, line 53 through page 1, column 2, line 2. See page 1, column 2, lines 74-83. See page 1, column 2, line 109 through page 2, column 1, line 2. Assuming that the intended target or line of play is along a substantially horizontal surface, as is often the case when using a putter, the face (a^2) must be in a vertical orientation in order to be square to the line of play. If the face (a^2) has an inclined angle of loft, as argued by the applicant, the face is no longer squared to the line of play. The only way that the putter face can be square to the line of play (i.e., the plane of the face is square or perpendicular to the line of play) is if the face is located in a vertical plane, at least for those times when the line of play or target is located on a horizontal plane, as outlined above. Moreover, Reach specifically teaches that when the sighting line (c) is cast in the head (in one example), the line serves as an index line to which the face must be formed parallel (page 2, column 1, lines 3-6). Thus, the argument made by Maltby on page 4, lines 13-15 of the declaration and stating that "...while the sighting line c may be used to square the clubface a2 to a line of flight, the sighting line cannot be used to place the face a2 of the putter in a vertical plane." is not deemed persuasive. It is further noted that the

applicant cannot only observe what is shown in Figure 2 of Reach without considering the entirety of the Reach disclosure. Here, Reach never discloses or even hints that the face (a^2) should be inclined. Plus, there is no way to accurately determine if Figure 2 is showing a lofted face or simply appears to show a lofted face as a result of the line shading used. Every indication in Reach points to the fact that the face is squared at address and thus cannot be lofted, as vehemently argued by the applicant.

With respect to the argument under **(B)** above, Reach indicates that the line (c) is centered on the hosel. See page 1, column 2, lines 96-102. Reach indicates that the shaft extends upward from the hosel and is attached thereto (page 1, column 2, lines 71-74). Further, Figure 1 would appear to show that the shaft (b) is centrally aligned with the hosel (a'). Thus, if the sighting mark (c) is aligned centrally with the hosel, the sighting mark must also be aligned with the center axis of the shaft. And, if extended in the manner set forth by the combination under §103, the sighting line would clearly lie in a common plane with the longitudinal axis of the putter shaft.

With respect to the argument under **(C)** above, if the sighting line is extended and oriented on the shaft as explained under **(B)** supra, and considering once again that Reach specifically teaches that when the sighting line (c) is cast in the head (in one example), the line serves as an index line to which the face must be formed parallel (page 2, column 1, lines 3-6), then it must follow that the face (a^2) would be in a plane parallel to a sighting line extended up the shaft (b) of Reach.

With respect to the argument under **(D)** above, Seisaku details that at least the face side (4_1) of the tape (4) is a straight line and is placed on the shaft so that it is

parallel to the face (2) of the putter. Applicant's claim 26 sets forth in part that the putter comprises, "... a line having a first portion extending along a substantial portion of the surface of the shaft, ..., said portions of said line being disposed in a common plane with said longitudinal axis of the shaft..." . The claim language, for example, never stipulates the width of the line and never stipulates that the line includes a straight edge that is contained in a common plane with the longitudinal axis of the shaft. In Seisaku, at least a portion of the width of the tape (4) is contained along the longitudinal axis of the shaft. The novelty in Seisaku lies in installing the tape on the shaft so that the leading edge of the tape is straight and thus parallel to the face plane. There is no stipulation in Seisaku that would preclude the skilled artisan from placing the leading edge in a common plane with the longitudinal shaft axis in a case, for example, when the tape used exhibits a narrow width dimension. Moreover, even if one were to continue to argue that the straight edge of the tape in Seisaku is not contained within a common plane that includes the longitudinal axis of the shaft and that the skilled artisan would not have been motivated to place the straight edge of the Seisaku tape in a common plane with the shaft axis, it is not seen how having the straight edge of the tape slightly forward of the plane containing the longitudinal axis of the shaft, as would appear to be the case in Seisaku, would be of any disadvantage to the golfer. Such an arrangement would clearly appear to be dependent on the width of the material from which the tape is fabricated.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sebastiano Passaniti whose telephone number is 571-272-4413. The examiner can normally be reached on Mon-Fri (6:30-3:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 571-272-4415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

S. Passaniti

Sebastiano Passaniti
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Art Unit 3711

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February 5, 2005